

REMARKS

In the Office Action¹ mailed December 9, 2008, the Examiner took the following actions:

- (a) rejected claim 21, 39, and 40 under 35 U.S.C. § 101;
- (b) rejected claim 21 under 35 U.S.C. § 112, second paragraph, as indefinite;
- (c) rejected claims 1-3, 7-11, 13, 15-22, 26-30, 32, and 34-39 under 35 U.S.C. § 103(a) as being anticipated by *Todd* (U.S. Patent App. Pub. No. 2003/0061093) in view of *Walker* (U.S. Patent No. 5,949,044);²
- (d) rejected claims 4-6, and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over *Todd* in view *Walker*, and in further view of *Johnson* (U.S. Patent App. Pub. No. 2005/0021457);
- (e) rejected claim 14 and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Todd* in view of *Walker*, and in further view of *Watson* (U.S. Patent No. 5,991,750); and
- (f) rejected claim 40 under 35 U.S.C. § 103(a) as being unpatentable over *Johnson* in view of *Todd*.

By this Amendment, Applicant amends claims 1, 11, 13, 15, 16, 21, 24, 25, 30, 32, 34, 35, and 38-40, cancels claims 8, 10, 27, and 29 without prejudice or disclaimer, and adds new claims 41-43, which include recitations previously presented but currently deleted from independent claims 1, 21, and 38, respectively. No new subject matter

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

² The listing of claims rejected at Item 19 of the Office Action does not correspond to the claims addressed under item 19. Applicant understands this to be a clerical error and thus assumes the Examiner intends to reject the claims under 35 U.S.C. § 103(a) as unpatentable over *Todd* in view of *Walker* as identified in the paragraphs following item 19 and preceding item 20.

has been added. Claims 12 and 31 were previously canceled. Accordingly, claims 1-7, 9, 11, 13-26, 28, 30, and 32-43 are pending and under current examination.

Rejection of Claims 21, 39, and 40 under 35 U.S.C. § 101

The Office Action asserts that claims 21, 39, and 40 are directed to non-statutory subject matter. See Office Action, pp. 2-3. In response to this rejection, and without conceding to the Office Action's assertions regarding alleged non-statutory matter, Applicant has amended independent claims 21, 39 and 40 to recite that the invention is tied to a particular machine, namely, a computer. Applicant submits that the amendments overcome the 35 U.S.C. § 101 rejection, and independent claims 21, 39, and 40 are therefore allowable. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 101 rejection.

Rejection of Claim 21 under 35 U.S.C. § 112, Second Paragraph

The Office Action rejected claim 21 under 35 U.S.C. § 112, second paragraph, as being indefinite. See Office Action, p. 3. The Office Action particularly alleged that "[a] system claim must cite structure of the system, which Applicant has not cited." Office Action, p. 3. In response to this rejection, and without conceding to the Office Action's assertions regarding indefiniteness, Applicant has amended claim 21 to distinctly recite the claimed subject matter. In view of this claim amendment, Applicant respectfully requests that the rejection of claim 21 under § 112 be withdrawn.

Rejection of Claims 1-3, 7-11, 13, 15-22, 26-30, 32, and 34-39 under 35 U.S.C. § 103

Applicant requests reconsideration and withdrawal of the rejection of claims 1-3, 7-11, 13, 15-22, 26-30, 32, and 34-39 under 35 U.S.C. § 103. In order to have a proper rejection under 35 U.S.C. § 103(a), the Examiner must properly resolve the *Graham*

factual inquiries, the proper resolution of which is the requirement for establishing a framework for an objective obviousness analysis and demonstrating a *prima facie* case of obviousness. See M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In order to demonstrate a *prima facie* case of obviousness, among other things, the Examiner must properly determine the scope and content of the prior art and must properly ascertain the differences between the claimed invention and the prior art, as required under M.P.E.P. § 2141. The Office Action does not establish a *prima facie* case of obviousness at least because the Examiner incorrectly interprets the contents of *Todd* and *Walker* and consequently misses the sizable differences between the references and the claimed invention.

Claim 1, as amended, recites, *inter alia*:

A method for providing incentives for a first financial account held by a user and associated with a first financial account provider, wherein the user also holds a second financial account associated with a second financial account provider, the method comprising:

configuring the first financial account to provide a first incentive when less than a threshold quantity of transactions are performed using the second financial account;

configuring the first financial account to provide a second incentive when more than the threshold quantity of transactions are performed using the second financial account, wherein the first incentive is more attractive than the second incentive; . . .

determining, by the computer system, whether to apply the first incentive or the second incentive; and

applying, by the computer system, the first or the second incentive to the first financial account based on the determining.

Todd in view of *Walker* does not teach or suggest at least these elements of claim 1. In particular, *Todd* discloses a system for rewarding customers of a financial service provider “based on transactions completed using services of the financial service provider. *Todd*, ¶ [0033]. *Todd* further teaches allowing one customer to transfer rewards to the account of another customer. *Todd*, ¶ [0033]. *Todd* does not, however, teach the above quoted-recitations of Applicant’s claim 1. Moreover, *Walker*, which teaches a system that allows a transferor to securely make payment or transfer credit to a transferee, also does not teach the above-quoted recitations of claim 1. *Walker*, col. 4, lines 17-27. Accordingly, there are substantial differences between the claimed invention and the prior art, and there is no *prima facie* case of obviousness.

For at least these reasons, claim 1 is not obvious over *Todd* and *Walker*, whether taken alone or in combination. Claim 1 is therefore allowable. Amended independent claims 21, 38, and 39, although different in scope, contain recitations similar to those discussed with regard to claim 1, and therefore are allowable for at least the same reasons.

Additionally, claims 1, 21, 38, and 39 are also allowable for another reason. Namely, the rejection of independent claims 1, 21, 38, and 39 under § 103(a) is improper because the alleged motivation to combine *Todd* with *Walker* is based on a faulty understanding of the teachings of *Todd* and *Walker*. Specifically, *Todd* teaches monitoring accounts of users of a single financial institution, and transferring rewards between users associated with the single financial institution. *Todd*, ¶ [0033]. As explained by *Todd*:

[t]he direct advantage to the [financial service] provider lies in eliminating the need to set up and administer multiple individual investment accounts. Further, the financial services provider retains use of the money represented by the accumulated value until the money is withdrawn or otherwise used by the customers. Also, because the financial services provider can administer the funds as a single account representing the value accumulated in multiple accounts, the provider can pursue the better returns often available only on significantly larger investments. *Todd*, ¶ [0028].

Todd teaches that it would only be advantageous to the financial service provider to administer this program for its own accounts. Therefore, to obtain *Todd*'s discussed advantage and make the invention useful, even when *Todd* discusses transferring rewards between two accounts both accounts must be associated with a single financial service provider. *Todd* therefore teaches away from modifying its system to include a second financial service provider.

Moreover, *Walker* suffers from its own deficiency. *Walker* teaches a system that allows a transferor to securely make payment or transfer credit to a transferee. *Walker*, col. 4, lines 17-27. Accordingly, neither party needs to give his credit card number to the other party. See *Walker*, col. 4, lines 26-27. Clearly this is intended for transferring funds between accounts of different users, as it would be nonsensical for a user to enter his credit card number in *Walker*'s system to prevent giving his credit card number to himself. *Walker* therefore teaches away from modifying its system to work for a single user with multiple accounts. Accordingly, *Walker* and *Todd* cannot be combined in the manner suggested by the Examiner because the combination would render the systems of both *Walker* and *Todd* unsuitable for their intended purposes.

See M.P.E.P. § 2143.01. In addition, both references teach away from the claimed

invention which recites, "a first financial account held by a user and associated with a first financial account provider, wherein the user also holds a second financial account associated with a second financial account provider," (claim 1, emphasis added, with similar recitations in claims 21, 38, and 39).

Accordingly, for these additional reasons, the Office Action does not establish a *prima facie* case of obviousness for claims 1, 21, 38, and 39 based on the combination of *Todd* with *Walker*. For these additional reason, claims 1, 21, 38, and 39 are allowable over the cited art. In addition, claims 2, 3, 7-11, 13, and 15-20 depend from claim 1, and claims 22, 26-30, 32, and 34-37 depend from claim 21. Therefore, for at least the same reasons set forth above in connection with claims 1 and 21, as well as by reason of reciting additional features not taught nor suggested by the cited references, the rejection of claims 2,3, 7-11, 13, and 15-20, 22, 26-30, 32, and 34-37 is legally deficient and should be withdrawn, and the claims allowed.

Rejection of Claims 4-6, 14, 23-25, and 33 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 4-6 and 23-25 as being unpatentable over *Todd* in view of *Walker* and in further view of *Johnson*. A *prima facie* case of obviousness has not been established because the cited art does not disclose or suggest the recitations of these claims, much less support a reasonable basis for suggesting the recitations would have been obvious.

Claims 4-6 and 23-25 respectively depend from independent claims 1 and 21. As explained, *Todd* in view of *Walker* fails to teach or suggest the recitations of claims 1 and 21. Therefore, for at least the same reasons set forth above in connection with claims 1 and 21, the rejection of claims 4-6 and 23-25 is legally deficient and should be

withdrawn, and these claims allowed. Moreover, *Johnson* fails to cure the aforementioned deficiencies of *Todd* in view of *Walker*. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 4-6, and 23-25 and allow the claims.

Similarly, Applicant traverses the rejection of claims 14 and 33 as being unpatentable over *Todd* in view of *Walker* and in further view of *Watson*. A *prima facie* case of obviousness has not been established because the cited art does not disclose or suggest the recitations of these claims, much less support a reasonable basis for suggesting the recitations would have been obvious.

Claims 14 and 33 respectively depend from independent claims 1 and 21. As explained, *Todd* in view of *Walker* fails to teach or suggest the recitations of claims 1 and 21. Therefore, for at least the same reasons set forth above in connection with claims 1 and 21, the rejection of claims 14 and 33 is legally deficient and should be withdrawn, and the claims allowed. Moreover, *Watson*, which is directed to pre-authorizing certain transactions (See *Watson*, Abstract), fails to cure the aforementioned deficiencies of *Todd* in view of *Walker*. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 14 and 33 and allow these claims.

Rejection of Claim 40 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 40 as being unpatentable over *Johnson* in view of *Todd*. A *prima facie* case of obviousness has not been established because the cited art does not disclose or suggest the recitations of these

claims, much less support a reasonable basis for suggesting the recitations would have been obvious.

Claim 40, as amended, recites:

configuring the first financial account to provide a first incentive when less than a threshold quantity of transactions are performed using the second financial account;

configuring the first financial account to provide a second incentive when more than the threshold quantity of transactions are performed using the second financial account, wherein the first incentive is more attractive than the second incentive;

applying, by the computer, the first incentive to the first financial account when the forecast goal is met; and

providing an incentive report to the user based on the applied incentive,

wherein the incentive report includes information associated with incentives that may have been applied to the first financial account based on different types of predetermined conditions.

As discussed above for claim 1, *Todd* does not disclose this subject matter (nor, for that matter, does *Walker*). Additionally, *Johnson* fails to cure the aforementioned deficiencies of *Todd*. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 40 and allow the claim.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of pending claims 1-7, 9, 11, 13-26, 28, 30, and 32-43 .

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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